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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,543	06/26/2001	Dale F. McIntyre	83014F-P	1842

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EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/891,543	Applicant(s) MCINTYRE ET AL.	
	Examiner John M. Villecco	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-10 and 12-19 is/are rejected.
- 7) ☒ Claim(s) 3,7 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/01</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - On page 1 of the specification, applicant cross references several copending applications. Applicant only gives titles and leaves blanks for the U.S. serial numbers and the filing dates. Applicant is required to update the specification to reflect the serial numbers and the corresponding filing dates.

Appropriate correction is required.

Claim Objections

2. Claim 1 is objected to because of the following informalities:
 - In line 5 of claim 1, applicant recites the phrase “recognizing a content identifier said roll of film”. It appears that the applicant has omitted a key word in the phrase before the word said. For examination purposes it will be assumed that applicant meant to use the phrase – recognizing a content identifier on said roll of film –.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the claims and the specification how the service of providing additional information can be useful in completing the service of providing additional information. This limitation appears to be redundant in that the applicant claims the service that is useful in completing the service. For examination purposes it will be assumed that the applicant is trying to claim including additional information with the service order for helping to complete the requested service.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, in line 6 applicant recites the limitation that the content identifier provides “information or instructions”. Later on, in line 11, applicant recites the limitation that the service provider forwards images after forming a copy of the image “in accordance with said instructions”. This limitation requires that instructions be present in the content identifier. Therefore, the previous limitation of “information or instructions” is rendered indefinite since the instructions would always have to be present.

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7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "to the user computer" in line 3. There is insufficient antecedent basis for this limitation in the claim. In the parent claim, claim 1, applicant recites the limitation of a computer of a recipient. It is unclear whether the limitation in claim 10 is referring to this computer or to a different user computer.

8. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 12-14, 16, 18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Okazaki et al. (U.S. Patent No. 2002/0002515).**

11. Regarding *claim 12*, Okazaki discloses a method of providing a service for allowing people to sell image or art on a website. More specifically, Okazaki teaches that a seller is

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capable of uploading images to a reception center and can change or manipulate the image in any manner. This step serves as the process of providing instructions to a service provider. See paragraphs 0172 to 0184. If the requester desires to sell the image it is displayed in the webpage for the purchaser. Okazaki discloses that a purchaser is capable of viewing a webpage (shown in Figure 12) for selecting an image to buy. The purchaser corresponds to the third party requester as claimed. The purchaser is capable of specifying the type of product that they want. This corresponds to the step of the service provider providing access to the digital image file for fulfillment of the service. The reception center is interpreted to be the service center.

12. With regard to *claim 13*, Okazaki discloses sending the user to a payment page (see paragraph 0151). This corresponds to the step of generating a bill for providing the requested service.

13. As for *claim 14*, Okazaki discloses that the user is able to enter an account number. It is inherent that a debt would be incurred against the account after requesting the service.

14. Regarding *claim 16*, Okazaki teaches that the purchaser is capable of selecting the type of product that they would like to buy. This information is interpreted to be additional information.

15. With regard to *claim 18*, Okazaki teaches that both the requester and purchaser are charged fees based on the actions that the user takes in composing or purchasing an image.

16. As for *claim 19*, Okazaki discloses that the requester is charged for making changes to the images which are then added to the image collection. See paragraph 0143.

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Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christophersen et al. (U.S. Publ. No. 2003/0110182) in view of Safai (U.S. Patent No. 6,715,003).**

19. Regarding *claim 1*, Christophersen discloses a method in which a roll of film is processed (scanned) into digital images and distributed over a communications network. More specifically, Christophersen discloses using a scanner (32) to process a roll of film (12) to convert the images on the roll of film into digital images. The images scanned by the scanner are sent to a gateway server (38) where they are logically grouped according to customer identifier information provided on the film (12). See paragraph 0038. The gateway server (38) is interpreted to be the service provider. The gateway server is capable of receiving requests from external users for obtaining and viewing the images stored in the gateway server. The gateway server stores several different copies of the images. See paragraph 0015.

Christophersen, however, fails to specifically disclose that the service provider forwards the digital images to a computer of a recipient over the communications network based on instructions. Safai, on the other hand, discloses an electronic camera (100) capable of capturing an image. More specifically, the camera includes a communication port (214) for communicating data externally. Safai discloses transmitting images using a plurality of

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communication devices (col. 6, lines 6-21). The images are transmitted to a service provider (600) for distribution (col. 14, line 64 to col. 15, line 5). Furthermore, Safai discloses the ability to attach an address to the image which the service provider processes and uses to send the image to the correlated destination (col. 8, lines 37-60). The address attached to the image and sent to the service provider is interpreted to be the content identifier. Inherently, the files sent to the service provider would have to be analyzed to extract the address data. This feature allows a user to take a picture of a subject and automatically transfer the images to specific people.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize the data associated with the roll of film and automatically transfer those images to the computer of the recognized address data, so that the process of transferring images becomes automated.

20. As for *claim 2*, Christophersen discloses that several different copies of the image sent from the scanner are stored in the archives (42). The user is able to access the images from a remote location (32-2) and can access any of the copies of images. See paragraph 0041.

21. With regard to *claim 4*, Christophersen discloses that full resolution (FR) images are transferred to the gateway server (38) where they are then processed into images of several resolutions (TN, PV, SCR). Therefore, the images arrive at full resolution and an image of lesser resolution is stored.

22. **Claims 5, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (U.S. Patent No. 6,715,003) in view of Christophersen et al. (U.S. Publ. No. 2003/0110182).**

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23. Regarding *claim 5*, Safai discloses a camera which is capable of capturing an image and storing the images at a service provider for later viewing. More specifically, Safai discloses retrieving images from a specified user account (col. 16, line 65 – col. 17, line 16). The images are sent to the storage device (614) located at the service provider (600) after having been captured by the digital camera (100). The camera can transmit images wirelessly (col. 6, lines 14-18). After the images are sent to the service provider they can be retrieved by the user at the camera or automatically sent to a specified computer. Inherently, a copy of the image would be stored in the storage device in order to a camera to be able to retrieve the image.

Safai, however, fails to specifically disclose the ability to access the images from a computer. Christophersen, on the other hand, discloses that it is well known in the art to access images stored remotely using a computer. More specifically, Christophersen discloses a method in which a roll of film is processed (scanned) into digital images and distributed over a communications network. Christophersen discloses using a scanner (32) to process a roll of film (12) to convert the images on the roll of film into digital images. The images scanned by the scanner are sent to a gateway server (38) where they are logically grouped according to customer identifier information provided on the film (12). See paragraph 0038. The gateway server (38) is interpreted to be the service provider. The gateway server is capable of receiving requests from external users for obtaining and viewing the images stored in the gateway server. The gateway server stores several different copies of the images. See paragraph 0015 and 0041. By allowing a user to access the service provider using a computer, the user is given much more flexibility when trying to access and manipulate images. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to access the

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images stored remotely, as in Safai, using a remote computer so that the user does not have to access the images using only the camera, thereby offering the user much more flexibility.

24. As for *claim 6*, both Safai and Christophersen disclose that the service provider stores a copy of the images for future access by the user or third parties. Safai would inherently store a copy of the image so that the user can access the images from the remote server. Additionally, Christophersen discloses storing several different versions of an image for the user to view (paragraph 0015).

25. With regard to *claim 8*, Christophersen discloses transferring the images at the highest resolution possible (FR) and then storing several copies of the image at lower resolutions (paragraph 0039).

26. Regarding *claim 9*, Safai discloses that the electronic capture device is an electronic camera (col. 5, lines 8-14).

27. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki et al. (U.S. Patent No. 2002/0002515) in view of Wang et al. (U.S. Patent No. 6,028,603).**

28. Regarding claim 17, as mentioned above in the discussion of claim 12, Okazaki discloses all of the limitations of the parent claim. However, neither of the aforementioned references specifically discloses that the service comprises cataloging the media files. Wang, on the other hand, discloses that it is well known in the art to catalog images over the internet. See column 3, lines 40-65 and col. 6, lines 5-40. This feature makes it possible to personalize the image data being presented to the user. Therefore, it would have been obvious to one of ordinary skill in the

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art at the time the invention was made to modify Okazaki so that the user can modify the data that is being presented.

29. **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki et al. (U.S. Patent No. 2002/0002515) in view of Wilkman (U.S. Publ. No. 2002/0032609).**

30. Regarding *claim 15*, as mentioned above in the discussion of claim 12, Okazaki discloses all of the limitations of the parent claim. However, Okazaki fails to explicitly disclose the use of loyalty points in providing a requested service. Wilkman, on the other hand, discloses that it is well known in the art to use loyalty points when performing services over an internet. See the abstract. This method provides an alternate way of paying for services, while also conveying a benefit upon the consumer for their loyalty. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use loyalty points to pay for the service in Okazaki so that a method of payment beneficial to the user is implemented.

Allowable Subject Matter

31. Claims 3, 7, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

32. The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claims 3 and 7*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest using content identifiers associated with

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the user to automatically recognize content within the digital image and automatically transmitting the content information correlated to the transmitted digital images.

As for *claim 11*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the service provider can look for images to which an icon provided by the user has been applied and automatically forward the images to the user.

33. Claim 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

34. The following is a statement of reasons for the indication of allowable subject matter:

Regarding *claim 10*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest storing the high resolution images for an ordering period after which the high resolution images are transferred to a users computer and the high resolution images are converted to low resolution image and added to the user's low resolution images.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
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or faxed to:

(703) 872-9306 (For either formal or informal communications intended for entry. For informal or draft communications, please label **"PROPOSED"** or **"DRAFT"**)

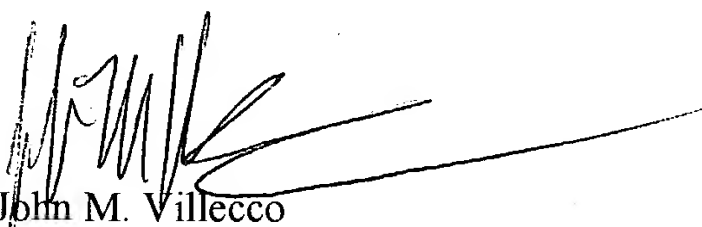
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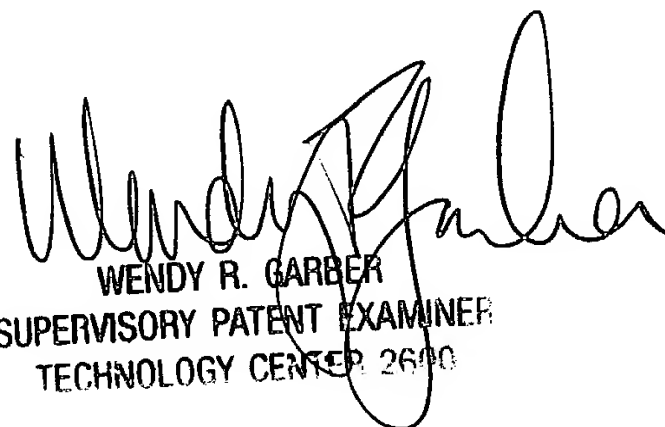
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (703) 305-1460. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John M. Villecco
November 8, 2004


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600